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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,764	06/01/2001	Jeffry J. Grainger	020313-000110US	2173

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/872,764	Applicant(s) GRAINGER ET AL.	
	Examiner Mary Cheung	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17,38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17,38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/26/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This office action is in response to the amendment filed on May 30, 2006. Claims 1-17 and 38-39 are pending. Claim 1 is amended. Claims 18-37 are canceled.

Response to Arguments

2. Applicant's arguments filed May 30, 2006 have been fully considered but they are not persuasive.

In response to the applicant's arguments that ePAVE fails to teach creating an application, examiner believes that ePAVE teaches this matter. The paper version of the patent application may already exist; however, ePAVE, teaches how to create an electronic version of a patent application, which can be filed electronically to USPTO (pages 19-22). EPave also teaches filing new utility patent application that guides a user to create an electronic patent application according to current patent business rules (see page 1 "ABOUT EFS PILOT RELEASE" section 5).

The applicant argues that ePAVE fails to teach "providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out". Examiner respectfully disagrees because ePave teaches an electronic invention disclosure forms to be filled out, such as patentee information, and attorney or agent information (pages 19-21). In addition, the applicant argues that since ePave software must be installed on a local computer, it fails to teach "providing, from a first server computer to a client computer". Examiner believes that ePave software program can be downloaded from UPSTO related website to the user computer so that the user can

create electronic version of a patent application (page 12); thus, the ePave software program is provided by/from a first server computer, which is USPTO server system.

The applicant further argues that ePave fails to teach "receiving a filled-out invention disclosure form on a first server; and automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server". Examiner believes that ePave teaches electronically submitting a filled-out patent application by a user, and the USPTO's computer will then send acknowledgement receipt (see pages 29 and 49), that correspond the limitation "receiving a filled-out invention disclosure form on a first server". ePave further teaches by click on "Send To USPTO" button, the user's input regarding to the patent application will be filed as an electronic patent application in USPTO, that corresponds to the limitation "automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3 and 38-39 are rejected under 35 U.S.C. 102(a) as being anticipated by ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000.

As to claim 1, ePave discloses a computer-implement method for securing intellectual property rights, the method comprising (page 1):

- a) Providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out is taught by ePave as allowing a smart electronic invention disclosure form to be downloaded from USPTO's computer to a client computer, and the electronic invention disclosure form can be filled out (pages 1, 9, 12, 17-21);
- b) Actively prompting a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form (pages 19-21);
- c) Receiving a filled-out invention disclosure in electronic form on the first server is taught by ePave as submitting a filled-out invention disclosure in electronic form to USPTO's computer, and USPTO's computer will send acknowledgment receipt to the client computer upon receiving the form (pages 29-31, 49).
- d) Automatically converting the invention disclosure form into a form of a patent application in response to a single click instruction input by the user on the first client computer and received by the server (pages 18-19, 28-29).

As to claim 2, ePave discloses active prompting an inventor by the disclosure form to provide best modes known to the inventor for practicing an invention (pages 17-21, 51-52).

As to claim 3, ePave discloses active prompting an inventor by the disclosure form to provide detailed information required to enable one of ordinary skill to practice the invention (pages 17-21, 51-52).

Claims 38-39 are parallel with claim 1; thus they are rejected for the similar reason as claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000.

As to claim 4, ePave discloses the smart disclosure form prompts an inventor to input information in pre-selected fields (pages 18-19). EPave does not specifically state that prompting an inventor by the disclosure form to identify co-inventors if there are any. It would have been obvious to one of ordinary skill in the art to include the feature of identifying co-inventions if there are any in the system of ePave because it is well known in the art that lots of applications have multiple inventors, and all the names of the inventors along with their signatures are required to be included in the applications. Thus, in order to compliance with patent law/rule and to further avoid any legal issues about inventorship, one of ordinary skill in the art would have been motivated to include the feature of identifying co-inventors in the system of ePave.

As to claim 5, ePave discloses wherein information in pre-selected files of the invention disclosure form is selectively placed in a pre-selected location in said patent application (pages 18-19, 28-29).

As to claim 6, ePave discloses the single click also causes the patent application to be filed at a patent office (pages 28-29).

As to claim 7, ePave discloses the patent application is filed at the patent office electronically (pages 28-29).

As to claim 8, ePave discloses executing the patent application with a digital signature of an inventor, assignee, or registered patent practitioner before the patent application is filed (pages 19-20, 28-29).

As to claim 11, ePave discloses transmitting notification that the patent application was filed to an intellectual property server (pages 24-31).

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of Hsu et al., U. S. Patent 5,982,898.

As to claims 9-10, ePave discloses encrypting the patent application before submitting the patent office (page 33); maintaining a registry of public keys at the patent office (page 5); decrypting of the patent application by the patent office is inherent for the system of ePave because the patent office has to decrypt the patent application in order to read. EPave does not specifically teach encrypting the patent application with a private key of the inventor, assignee, or registered patent practitioner, and decrypting the patent application with a public key for the inventor, assignee, or registered patent practitioner. However, Hsu teaches using private key and public key to encrypt or

decrypt information (abstract and Figs1-2). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the feature of using private key and public key to encrypt or decrypt the patent application for preventing unauthorized access.

8. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of Whitmyer, Jr., U. S. Patent 6,182,078.

As to claims 12-14, ePave discloses a computer-implement method for securing intellectual property rights as discussed above. EPave does not specifically disclose automatic calendaring by the IP server of a deadline data for foreign filing under an international convention, transmitting a reminder communication from the IP server to a specified address at a specified time period before the deadline date, and automatic converting the provisional patent application to a non-provisional patent application. However, Whitmyer teach automatically generating a reminder regarding important events and transmitting the reminder to correspondent clients (column 3 lines 38-65 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the function of generating a reminder regarding important events, such as priority filing deadlines and transmitting the reminder to correspondent patent applicants because it would remind the patent applicants to submit proper documents before these deadlines.

9. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over ePave User Guide, published by U. S. Patent and Trademark Office on January 12, 2000 in view of U. S. Patent Application Specification Authoring Guide for WordPerfect

XML Template, published by U. S. Patent and Trademark Office on December 14, 1999.

As to claims 15-17, ePave discloses a method for electronically filing patent applications. EPave does not specifically disclose submitting drawings along with the electronic patent application. However, U. S. Patent Application Specification Authoring Guide for WordPerfect XML Template discloses this matter (page 26). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the function of submitting drawings along with the electronic patent application so that the applicant can submit all the necessary information in one single transmission, this easy task would attract more applicants filing patent applications electronically.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer, can be reached on (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300	(Official Communications; including After Final Communications labeled "BOX AF")
(571) 273-6705	(Draft Communications)

Mary Cheung
August 9, 2006



**MARY D. CHEUNG
PRIMARY EXAMINER**